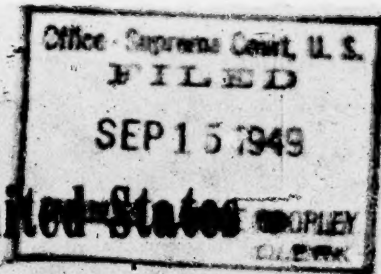


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SUPREME COURT, U. S.



IN THE  
**Supreme Court of the United States**

October Term, 1949.

No. 19

TODD C. FAULKNER,

*Petitioner,*

*vs.*

JOHN T. GIBBS,

*Respondent.*

BRIEF FOR TODD C. FAULKNER,  
PETITIONER.

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Point I. The claims in suit are invalid under R. S. 4888 and the doctrine of *Halldartou v. Walker*, because they do not particularly point out or distinctly claim the invention, but on the contrary use the functional statements "means for energizing," "means whereby," and "means for discontinuing" at the exact point of novelty. 30

A. The definition of the only element of novelty in Claim 3 by the functional statement "means for energizing the indicator's as the associated contact devices are operated," renders Claim 3 invalid under R. S. 4888. 35

Summary re. Claim 3. 41

B. Claims 6-10 are also invalid under R. S. 4888 because like Claim 3 they employ functional language to define their only novelty over the Nakashima patent. 42

Discussion of Claim 6. 43

Discussion of Claim 9. 47

Point II. Since Claims 6, 7 and 8 of the Gibbs patent were held not infringed by the new Fawn game because it omitted an essential element of said claims, Claims 9 and 10 which include the same essential element are not, as a matter of law, infringed by the new Fawn game. 49

Conclusion. 53

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**BRIEF FOR TODD C. FAULKNER,  
PETITIONER.**

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This is a suit for patent infringement brought by the Respondent John T. Gibbs against Petitioner Todd C. Faulkner in the United States District Court for the Southern District of California, Central Division, alleging infringement of claims 3 and 6-10 of Respondent's Patent No. 1,906,240 for a Game. The District Court held the claims in suit valid and all of them infringed by the game operated by Petitioner at the inception of the suit, but only some of the claims, infringed by a modified form of said game which was also in issue.

The United States Court of Appeals for the Ninth Circuit affirmed the decision of the trial court in all respects and denied a petition for rehearing. Certiorari was thereafter granted by this Court.

## THE OPINIONS OF THE COURTS BELOW.

The opinion of the Court of Appeals for the Ninth Circuit is reported at 170 F2 34, 79 USPQ 158 and appears in Volume III of the Record at pages 538-546.

The District Court's opinion was delivered orally at the close of the trial and appears at pages 282-289 of the Record. It was not reported. For a full understanding of the trial court's reasoning it is necessary to also read pages R. 260-282 which cover the general discussion between Court and counsel preliminary to the rendition of the opinion.

The Findings of Fact and Conclusions of Law of the trial court are found at pages 33-40 of the Record, and the Interlocutory Judgment at R. 41-43.

## JURISDICTION.

The Petition for Certiorari in this case was granted March 28, 1949.

The grounds for jurisdiction are:

1. The Decree of the Court of Appeals was entered October 8, 1948 [R. 547]. Petition for Rehearing was denied November 23, 1948 [R. 548].
2. The Decree was rendered in a suit in equity brought under the patent statutes to determine the issues of validity and infringement of Letters Patent issued by virtue of Revised Statute No. 4888 (35 USC 31).
3. The jurisdiction of this Court is invoked under 28 USC 1254.

## STATEMENT OF THE CASE.

### HISTORY OF THE LITIGATION.

The patent in suit was issued to the Respondent John T. Gibbs on May 2, 1933 for a Game, hereinafter referred to as the "Gibbs game." As stated by the Court of Appeals [R. 539], the Gibbs game in essence, "is an assembly or combination comprising a plurality of electrically interconnected game units, each of which units has the general outward appearance of the well known pinball machine. Each unit is operated by a separate player who competes with players operating the other units in the multiple assembly."

At the commencement of this suit the Petitioner was operating at Long Beach, California, a competitive game called the "Fawn" game. This game is referred to in the Record as the "old" or "original" Fawn game.

Subsequent to the filing of the Complaint herein Petitioner modified his game by incorporating a time clock therein *so that the players no longer competed with each other*, but instead played for a stipulated time controlled solely by the clock. This modified game is variously referred to in the Record as the "new" or "altered" Fawn game.

Thereafter Petitioner filed a Counterclaim [R. 12] praying for a declaratory judgment of non-infringement as to *both* the old and new Fawn games, and invalidity of the Gibbs patent.

At the trial, claims 3 and 6-10 were in issue and the trial judge decreed [R. 42] that all of said claims had been infringed by the old Fawn game. As to the *new* Fawn game, the Court ruled that *only* claims 3, 9 and 10 were infringed, and that claims 6, 7 and 8 were *not* infringed.

There are no specific findings of fact which set forth how or why claims 3, 9 and 10 were held to be infringed by the *new* Fawn game. Likewise nothing appears in either of the opinions below on this subject.

#### THE DISCLOSURE OF THE GIBBS PATENT.

As stated by Respondent in his specification [R. 303] his invention relates to a game "which embodies a plurality of electrically connected units arranged in such a manner that successive plays made by the players on their respective units will be indicated visibly or audibly, and the winning play made by any one of the players on a particular unit will operate to give an additional signal of such winning play and at the same time *discontinue* the signals of the successive plays made on the other units." It is necessary that the non-winning game units be immediately disconnected so as to have only one winner and avoid arguments.

By reference to Fig. 1 of the Gibbs patent [R. 295†] it is seen that each of the game units, of which there may be any number, includes a horizontal game board and a vertically disposed annunciator panel at the rear thereof.

Each game board is provided with a plurality of apertures into which a ball may be rolled by a player. Each of the apertures has a spring contact device S beneath it comprising a pair of contacts 53, 54 which are closed when a ball is dropped into the aperture.

Each annunciator panel includes a plurality of indicator lamps on the face thereof corresponding in number and arrangement with the apertures on each board and electrically connected with the contacts beneath the respective apertures. Each of the contact devices S has associated therewith a relay R with an armature R' for energizing its corresponding indicator lamp. When a ball is dropped into one of the apertures, the contacts 53, 54 underneath that aperture are momentarily closed to operate their relay R, which by virtue of its armature R', in turn energizes its corresponding indicator lamp.

The apertures in the game board are arranged in groups, and a winning play is made when a player has dropped the ball into all of the apertures of any group. In the form of the Gibbs game illustrated in his patent the indicators are grouped in vertical and horizontal rows so that a win is made when a row is completed. There are twenty-five indicators in all and a contact device and relay for each.

The units are electrically connected so that when a player has dropped a ball into all of the apertures of any one group or line of apertures on his particular unit, "supplementary audible and visible signals will indicate the winning play, and *simultaneous therewith* all of the indicators on the other units *will be de-energized* and only the indi-

cators on the winning unit will remain energized." [R. 303, lines 68-73.]

In Exhibit B [R. 371] which is an enlargement of Fig. 6 plus a portion of Fig. 10 of the Gibbs patent, the brown line traces the circuit for the relay R associated with the indicator number 1. Similar circuits for the other relays R are also provided. When the five relays R of the top row have all been operated to energize their respective indicator lamps, the win circuit shown in red is completed.

Whenever a win circuit is completed by energization of five relays in a row, horizontal, vertical or diagonal, a *win lamp L* at the top of the annunciator on the winning unit is illuminated. Also a holding relay R3 is energized, setting up the auxiliary circuit shown in green in Exhibit B, which causes the bell 69 to ring and all of the other game units to be de-energized.

It is thus seen that whenever a win circuit is completed, for example, a horizontal line of five as illustrated in red in Exhibit B, or a vertical line of five as illustrated in blue, or a diagonal line of five as illustrated in yellow in said exhibit, *supplementary means in the form of win light L and bell 69* are actuated and the indicators on all of the other units are *de-energized*, while the indicators on the winning unit remain energized.

## THE CLAIMS IN SUIT.

Claim 3 is a sub-combination claim directed to the construction and operation of a *single unit* of the Gibbs game as illustrated in Figs. 1 and 6 of the patent [R. 295 and 297]. Claims 6-10 are directed to the entire game comprising a plurality of said individual units interconnected so that a win on one unit will disconnect the rest as illustrated in Fig. 10 of the patent [R. 301].

To facilitate ready consideration of the claims we reproduce them here in outline form.

### CLAIM 3.

#### 3. A game apparatus comprising

- (a) a board having a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators, means for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators and said contact devices corresponding in number and arrangement and sub-divided into corresponding groups,
- (b) *means for energizing* said indicators as the associated contact devices are operated,
- (c) an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized,
- (d) and *supplementary means for indicating* a winning play when all of the indicators in one of said groups have been energized.

The Court's attention is respectfully called to the fact that claim 3 is couched in very general language.

For example, the board of element (a) above is *not* specified to have any apertures therein, but on the contrary, the contact devices are merely said to be located on the board.

Further, with respect to element (a) the indicators are not specified as lamps, but merely as indicators, which literally includes movable means and other devices for conveying intelligence.

Likewise neither the indicators nor the contact devices are limited in number or arrangement, it merely being specified that they shall correspond. In other words, *they are not limited to five rows of five* as illustrated in the Gibbs drawing, but may include three rows of three or any other combination, such as four rows of five, or six circles of 10, so long as they correspond.

Element (b), it should be noted, is defined entirely in functional language as "means for energizing" with no particularity as to the means.

Likewise, as to element (d) "supplementary means for indicating a winning play" may include a win lamp, a bell, or any other *supplementary* indicating or signalling means operated in any manner whatsoever to show that a win has been accomplished.

**CLAIM 6.**

6. A game apparatus comprising a plurality of units electrically connected together,

- (a) each of said units including a plurality of contact devices and a plurality of indicators corresponding in number and subdivided into corresponding groups,
- (b) *means for* electrically connecting the contact devices with the corresponding indicators,\* said indicators *adapted to be operated when and as* objects are moved by the players into engagement with the contact devices,
- (c) *means for* electrically connecting said units together and with a source of electric current,
- (d) and *means whereby* when all of the indicators in any group of any one of said units have been operated to complete a winning play, *the indicators on all of the units except the winning unit will be de-energized, while the indicators at the winning unit will remain energized, for the purpose described.*

With respect to claim 6 it is to be noted that *it does not even specify a game board.* It is merely stated in element (a) that there are a plurality of contact devices and a plurality of indicators. *Nothing is said as to their location with respect to each other, whether they are hori-*

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\*Note: For clarity, element (c) has been transferred from this point to its present position in the outline.

zontal or vertical or whether the contact devices are associated with holes in a board, targets to be shot at, or darts to be thrown.

Element (b) does not even say means for energizing indicators, but merely states broadly that the indicators are "*adapted to be operated* when and as objects are moved," etc. This can include an extremely wide range of indicators and means for operating them.

Element (d) is likewise couched in *functional* language, merely specifying "means whereby" etc. In so far as the wording of the claim goes these means may be electrical, mechanical, acoustical, hydraulic, pneumatic or any other means of any shape, character, or fashion whatsoever now known or hereafter to be discovered which will accomplish the result stated in the claims.

Claim 7 is dependent upon claim 6, merely adding thereto the "independent supplementary signal" for indicating a win.

Claim 8 is likewise dependent on claim 6 and adds thereto the win signal of claim 7 plus "*means* under the control of an operator for opening and closing the circuits of all of said units simultaneously at will." This is the main power switch that all such games have as a matter of course.

Claims 7 and 8 do not amplify or particularize any of the functional statements of claim 6, or supply any of the above-discussed elements missing therefrom. Consequently claims 7 and 8 must stand or fall with claim 6.

CLAIM 9.

9. A game apparatus comprising a plurality of electrically connected units,

- (a) each including a game board with a plurality of apertures therein, and an annunciator with a plurality of indicators thereon,\* said indicators and said apertures corresponding in number and subdivided into corresponding groups,
- (b) [electrical contacts adjacent each of said apertures connected in the circuits of said indicators,] *whereby when* objects are deposited in said apertures by the players at the several units, corresponding indicators will be energized,
- (c) a *supplementary* signal circuit on each of said units, and *means for holding* said signal circuit open until all of the indicators of any group on each of said units have been energized, *and for closing* said signal circuit when all of the indicators of any unit have been energized,
- (d) and *means* controlled by the closing of the signal circuit of the winning unit *for discontinuing* the signals and opening the circuits of the indicators on *all other* units.

Claim 9 is more specific than claim 6 as to element (a), for it specifies *a game board with a plurality of apertures therein*, whereas claim 6 does not specify a board at all or any apertures at all. However, again it is to be noted that neither the number nor pattern of the indicators or contact devices is specified. They can be in rows, circles,

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\*Note: The part of element (b) in [ ] has been transferred from this point to its present position in the interest of clarity.

stars or cubes so far as the wording of the claim is concerned. Likewise the indicators are not specified to be lamps.

As to element (b), claim 9 uses practically the same functional language as claim 6, merely specifying a result to be accomplished.

Element (d) specifies "means for discontinuing," the only limitation of such means being that they be "controlled by the closing of the signal circuit." In so far as the terms of this claim go this means could be electrical, mechanical, hydraulic or any other type as desired.

Claim 10 is dependent upon claim 9 and merely adds thereto "an audible signal commonly connected with all of said units and *adapted to be operated* upon the closing of the supplementary signal circuit of any of said units." Hence claim 10 must stand or fall with claim 9 because it does not amplify or particularize any of the functional language used in claim 9.

With respect to all of the Gibbs claims it should be noted that not one is limited to a ball, all using the broad word "object" which of course can include all kinds of things, such for example as the weighted peanuts shown in the Hayashi patent hereinafter mentioned.

Likewise there is nothing in any of the claims specifying whether or not one, or a plurality of, *objects* is to be used. Even in claim 9 which is the only claim specifying apertures in the game board, it is *not* mentioned whether or not the balls *pass through* the apertures *or are retained therein*. It is merely stated that when objects are deposited in the apertures the indicators will be energized. The "means" for accomplishing this result is, however, left to conjecture.

### THE PRIOR ART.

Respondent admits on page 3 of his Brief opposing the Petition for Writ of Certiorari that the Gibbs patent "utilizes old elements such as playing boards with holes therein, annunciator panels with electric lights, electrical switches, relays and circuits." That these elements, as well as various combinations thereof, were old in the art prior to Gibbs is fully borne out by the prior art patents of record in this case.

At the time Gibbs made his invention it was old and well known in the art to combine a playing board having a plurality of holes and contact devices with an annunciator panel having a plurality of indicator lights, and to electrically connect the contact devices and indicators whereby the indicators would be energized when a ball was rolled into any one of the holes on the playing board. Such games are shown by Nakashima, Hayashi and other patents of record. It was also old as shown by Nakashima to provide supplementary signal means for indicating a win.

Similarly it was old and well known when Gibbs made his invention to electrically interconnect a plurality of game units, each of which units had electrical contact devices which would energize indicator devices whereby the players could visually watch the progress of their play. The patents to Chester, Prina, Wallace, Higuchi and others illustrate these features and all disclose electrical circuits whereby when a win is accomplished on one game unit, all of the non-winning units are automatically disconnected, preventing further play thereon.

The Court's attention is particularly called to the fact however that the Patent Examiner who handled the Gibbs

application did not cite a single patent showing a competitive group game made up of a plurality of units wherein a win on one unit automatically disconnects all of the other units.

The prior art patents will now be abstracted in the order of their appearance in the Record.

### SINGLE-GAME PATENTS.

Nakashima Pat. No. 1,678,573 [R. 376-381].

The patent to Nakashima discloses a game apparatus (see Figs. 1, 2 and 3) comprising a board with a plurality of apertures therein arranged in rows, nine of which apertures have electrical spring contact devices therebelow adapted to be closed by a ball rolled over the board and into the apertures. The other apertures are merely hazards as stated in the specification. Nakashima also has an annunciator panel with nine electric indicator lamps thereon, the indicators and contact devices thus *corresponding in number*. The indicator lamps of Nakashima are electrically connected to a source of electric current and to said contact devices, and are energized as their associated contact devices are operated. An electrical circuit is also provided (see Fig. 4) which remains open until *all of the indicators* of any one of the groups have been energized, whereupon the circuit becomes effective to operate *supplementary signal means* in the form of a bell 14 to indicate that a winning play has been made.

Hayashi Pat. No. 1,614,471 [R. 383-390].

This patent discloses a game of the type shown by Nakashima and Gibbs having a board with a plurality of apertures into which a rolling object may fall, and an

annunciator board with a plurality of indicator lamps thereon. Each indicator is electrically connected to a spring contact device beneath an aperture and is energized as its associated contact device is operated by an object (peanut) falling therein. The indicators and contact devices correspond in number *and arrangement* and are subdivided into vertical and horizontal rows, the scores being dependent upon which group of indicators is energized during the play.

**Esmarian Pat. No. 1,618,912 [R. 391-395]**

Esmarian also shows a game board with a plurality of apertures adapted to receive a ball rolling across the board, each of said apertures having a spring contact device beneath it to be operated by a ball passing into the aperture. An annunciator panel is provided at the back of the game board having a plurality of indicator lamps *corresponding in number to the apertures in the playing boards*. The indicators are electrically connected with the contact devices so that the indicators are energized when and as objects are moved by the players into engagement with the contact devices to operate the same, *i. e.*, when objects are deposited in said apertures, the corresponding indicators will be energized.

**Mader Pat. No. 1,622,330 [R. 397-405]**

Mader likewise shows a game board with a plurality of apertures therein beneath each of which is a spring contact device in the form of a pair of resilient contact members. At the rear of the game board is an annunciator panel having four rows of five indicator lamps *arranged in horizontal and vertical lines* as in the Gibbs patent. As in the other prior art patents and in the Gibbs patent, the

indicators are connected with a source of electric current and with said contact devices whereby they are energized as their associated contact devices are operated by engagement of a ball therewith.

**Schneider Pat. No. 1,788,336 [R. 408-410]**

Schneider shows a game board provided with a plurality of apertures at its rear end and a plurality of indicator lamps corresponding in number and arrangement with the apertures with the exception that the apertures are vertically aligned, whereas the indicators are horizontally aligned. Each of said apertures is provided with a movable contact device in the form of a balanced paddle assembly immediately there below adapted to be engaged by a ball falling through the aperture whereby its associated indicator is energized. While none of the Gibbs claims specify that a single ball shall be used in playing his game, it is to be noted that *the Schneider patent uses a single ball which returns to the player after it has actuated the contact device and energized the corresponding indicator lamp.*

**McGregor Pat. No. 1,260,691 [R. 411-421]**

McGregor discloses an electrically operated target apparatus provided with a plurality of relays successively operated to make up segments of a circuit so that when all of the relays have been operated a control relay will disconnect one circuit and make another. These circuits are very similar to the relay circuits used in the Gibbs game.

PRIOR ART GAMES IN WHICH PLAYERS COMPETE  
WITH EACH OTHER.

Chester Pat. No. 1,598,711 [R. 424-434].

The Chester patent is the first of the *competitive* game patents in the Record, not one of which was cited against Gibbs by the Patent Office. Chester shows a *plurality of electrically interconnected individual game units, each operated by an individual player*. Each game has a contact device operated by a wheel, and indicating means in the form of a pair of dancers which advance around a circular track as they are successively energized by the contact devices. Thus the position of the dancers gives a visual indication of the progress of the play at all times. When the dancers reach their goal, a win has been accomplished. Means are provided in the form of a win switch and relay whereby *when a win has been made on any one of said units all of the units except the winning unit will be de-energized, and a signal lamp at the winning unit will be energized to indicate the win*. The near identity between the electrical circuits of the Gibbs and Chester games is evident from a comparison of the diagrams of Exhibits G and H [R. 529 and R. 531, respectively].

Wallace Pat. No. 1,697,701 [R. 436-447].

This patent covers the apparatus referred to by Gibbs in his testimony as the "grunt derby" [R. 76, 147] and is *the competitive game which he was operating when he made the alleged invention of the patent in suit*. The Wallace game provides a plurality of electrically interconnected game boards, each provided with a plurality of *apertures therein beneath which is a spring contact device*

common to all of the apertures. Each of the Wallace game boards is provided with a sloping panel at the rear thereof having a movable indicator which is operated when and as balls are moved by the players into engagement with the contact devices. In the Wallace game the indicator is in the form of a pig which travels up a miniature race track, the electrical connections being such that when the contact device beneath the apertures is operated by a ball passing through the aperture, the motive means of the indicator is energized to incrementally move the indicator along the track to a new position. Means are provided whereby when the winning or final play has been made on one unit and the pig has reached his goal, *all of the units except the winning unit are de-energized.* Also supplementary signal means in the form of a win lamp and a bell are operated to indicate the end of the game.

**Higuchi Pat. No. 1,454,968 [R. 450-467].**

This patent illustrates the competitive game known as the "Coney racer" with which Gibbs admitted [R. 76] he was familiar at the time he designed his own game. The Higuchi game is similar to the Wallace pig game, but the indicators are in the form of rabbits moving along a track. The indicator device in each game unit is electrically connected with a source of current and a contact device which is operated by the player manipulating a ball through the medium of a catapult. Whenever the contact device is operated by the ball falling thereon the indicator device is energized, causing it to move another notch toward the goal. Supplemental means in the form of a win lamp is provided for indicating a winning play. As mentioned, the indicators (rabbits) are

adapted to be operated when and as objects are moved by the players into engagement with the contact devices, and means are provided whereby when the indicator of any one of said units has been operated to complete a winning play the indicators on all of the units except the winning unit will be de-energized.

**Prina Pat. No. 1,518,754 [R. 470-484].**

Prina shows a competitive game made up of a plurality of units electrically connected together, each unit operated by a separate player, the results of the player's progress being "made manifest along a visible field and preferably by means of a progressive series of lamps for each unit" [R. 477].

Each game unit is provided with a manipulator comprising a wheel connected to a contact shoe which engages contact devices in the form of buttons, each of which is connected to an *indicator lamp*. As the contact devices are operated their associated indicator lamps are energized. In other words, *Prina has a plurality of contact devices electrically connected to a plurality of indicator lamps*; said indicators and contact devices *corresponding in number and arrangement* with means being provided for energizing said indicators as the associated contact devices are operated. An electrical circuit is provided which is open until all of the indicators of one of said units have been energized, and *supplementary means in the form of a win light* indicates a winning play when all of said indicators have been energized.

Prina also shows electrical means whereby when all of the indicators of any unit have been operated to complete a winning play the indicators on all of the units except the winning unit will be de-energized, while the indicators at the winning unit will remain energized.

Irsch Pat. No. 1,458,884 [R. 486-494].

This patent shows another competitive game wherein a plurality of individual game units are electrically connected together in such manner that when a win is made on one unit the win signals on the other units are disconnected. Each unit comprises a lever to be manipulated by the player so that he can advance a duck along a track. When one player causes his duck to travel the full length of the track and deposit an egg into a cup or nest an *annunciator light is illuminated* and the signals for the other units are incapacitated.

### The Original Fawn Game.

Petitioner's original Fawn game is shown best in the photographs [R. 325-339], the wiring diagram [R. 341] and the colored perspective drawings of Exhibit F [R. 527]. As seen from the above-mentioned exhibits, the original Fawn game comprises a number of game units, each having a board with a plurality of apertures therein *arranged in two transverse rows*, and an annunciator panel at the rear of the board having a similar number of indicator lamps *but arranged in five rows instead of two*. Below each of the apertures is a "see-saw" switch arm in the form of a balanced paddle adapted to be engaged by a ball passing through the aperture. Once the paddle is depressed by the ball it stays in that position until the game is over, thus maintaining its corresponding indicator lamp illuminated.

Referring particularly to Exhibit F [R. 527], the upper figure illustrates the position of the various mechanical parts of the Fawn game prior to the operation of any of the paddles. The paddles are colored yellow and their rear ends act as stops against which pins of the

wheels (both colored red) bear, and as long as the paddles remain with their rear ends down, the wheels are prevented from rotation [R. 184].

Extending across in front of all of the wheel pins is a win bar colored green, the lower end of which carries the small glass-enclosed mercury switch M. As the forward ends [the far ends in Exhibit F] of the paddles are moved downwardly, their rear ends will assume the position shown in the lower figure in Exhibit F [R. 527] where it will be seen that the rear ends of the first five of the paddles have been raised and have released the wheel pins previously held by them. Release of the fifth red pin permits a spring-operated cross bar colored blue to be pulled forwardly to move all of the vertical red pins against the green win bar which is thereby rocked forwardly sufficient to close the mercury switch M.

It will be understood that the blue win bar cooperates only with the five wheels which correspond to the row of five lights across the top of the annunciator, this being used for illustrative purposes. Since twelve win light combinations are possible, twelve cross-bars are provided, one for each possible combination of five wheels and lights. Selector pins are also provided which need not be described here.

One of these additional cross-bars, shown in brown in Exhibit F, is for producing one of the possible vertical combinations and extends across the machine to engage the pins on the wheels which correspond to these vertical lights. When the paddles for this vertical line of lights have released their pins the brown bar will swing forward and in so doing will move its five pins on the wheels corresponding to its particular line of vertical lights into

engagement with the green win bar to swing the same forward and close the mercury switch M.

A third cross-bar which has been colored purple extends across all of the wheels and engages pins that will be on those wheels which are associated with a diagonal line of lights so that when those wheels are released by operation of their paddles the purple cross-bar will swing forward to move the green win bar forward to close the mercury switch.

### **The New Fawn Game.**

The new or altered Fawn game retains the paddle and wheel mechanism of the original game, *but omits the win light on top of the annunciator panels and changes the electrical circuits so as to make the game non-competitive.* In the altered Fawn game a win on one unit does *not* de-energize or disconnect any other game units, but on the contrary, all players are allowed a *stipulated time* in which to try to effect a win.

The stopping of the game is controlled *solely by a time clock* which is started at the beginning of the game and continues for a predetermined time period. At the end of this time period the clock opens the main power switch, stopping the entire game for all players regardless of whether or not a win has been made. There may therefore be several winners or no winners. The wiring diagram for the time clock is found in Exhibit J [R. 535] from which it is seen that the entire operation of the game has been completely changed.

*The trial court found that the above mentioned changes in the new Fawn game made it non-competitive, and consequently ruled that it did not infringe claims 6, 7 and 8.*

This ruling by the trial court was not appealed by the Respondent.

As mentioned, the new Fawn game does not have a win light or bell or other supplementary means for indicating a winning play as called for in claim 3 of the Gibbs patent. The need for such is of course not present in a non-competitive game, since the players play against a clock rather than against each other.

### RELEVANT STATUTES.

The statutes under which this case arises which are necessary to be considered are as follows:

*Revised Statute, Section 4886 (35 U. S. C. 31):*

"Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, . . . not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

*Revised Statute, Section 4888 (35 U. S. C. 33):*

"Before any inventor or discoverer shall receive a patent for his invention or discovery he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and

process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery . . . .”

## THE QUESTIONS OF LAW INVOLVED.

*Question 1*—Is the doctrine of *Halliburton Oil Well Cementing Co. v. Walker, et al.*, 329 U. S. 1, 67 S. C. 6, 71 USPQ 175, condemning the use of indefinite and functional language at the exact point of novelty in patent claims for a combination of mechanical and acoustical elements, applicable to claims for a combination of mechanical and electrical elements where the only feature of novelty in the claims is described broadly in terms of “means,” or is said decision to be ignored as was done by the Court of Appeals in this case?

*Question 2*—Where a court holds an accused apparatus not to infringe certain patent claims because said apparatus does not include an essential element of said claims, is it not contrary to fundamental law and logic for the court in the same decision to hold other claims of said patent which specify the *same essential element*, infringed by the said accused apparatus?

## SPECIFICATION OF ERRORS.

Petitioner urges that the Ninth Circuit Court of Appeals erred:

1. In failing to reverse the Decree of the District Court holding the Gibbs Patent No. 1,906,260 valid and infringed by Petitioner;

2. In holding the Gibbs Patent No. 1,906,260 to be valid;

3. In holding the Gibbs Patent No. 1,906,260 to have been infringed by Petitioner;

4. In failing to hold that the law established by the decisions of this Court in *Halliburton Oil Well Cementing Company v. Walker, et al.*, 329 U. S. 1, 67 S. C. 6, 71 USPQ 175, and *General Electric Company v. Wabash Appliance Corp.*, 304 U. S. 364, 58 S. C. 899, were controlling and dispositive of the litigation;

5. In holding that claims 3, 6, 7, 8, 9 and 10 of Gibbs Patent No. 1,906,260 define the alleged improvement thereof with sufficient distinctness and clarity to comply with Revised Statute 4888, which requires a patentee to "particularly point out and distinctly claim the part improvement or combination which he claims as his invention or discovery."

## SUMMARY OF ARGUMENT.

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### POINT I.

The Claims in Suit Are Invalid Under R. S. 4888 and the Doctrine of *Halliburton v. Walker*, Because They Do Not Particularly Point Out or Distinctly Claim the Invention, but on the Contrary Use the Functional Statements "Means for Energizing," "Means Whereby," and "Means for Discontinuing," at the Exact Point of Novelty.

The requisite of definiteness in claims is a statutory requirement. This Court has consistently enforced this requirement. The public is entitled to know the exact scope of the monopoly granted to the patentee.

*General Electric Co. v. Wabash Corp.*, 304 U. S. 364, condemned the use of functional language in product claims.

*Halliburton v. Walker*, 329 U. S. 1, condemned the use of functional language in combination apparatus claims. The claims involved in the *Halliburton* case were for a combination of mechanical and *acoustical* elements.

The lower courts refused to apply the *Halliburton* rule to the claims here in suit which are for a combination of mechanical and *electrical* elements. Hence this appeal.

The claims here in suit are on all fours with the claims held invalid in the *Halliburton* case for failure to meet the requirements of R. S. 4888. Hence the Gibbs claims are *also* invalid under the statute.

Respondent has committed himself, and has been committed by the courts below, to a literal interpretation of his functional claims. He is not now entitled to have his claims judicially narrowed to save them from the statute.

Respondent by the use of his functional claims has been enabled to extend his monopoly beyond the true scope of his invention, if any, and thus prevent the use by others of otherwise unpatented machines. Such undue extension of the patent monopoly has been consistently condemned by this Court.

A. The Definition of the Only Element of Novelty in Claim 3 by the Functional Statement "Means for Energizing the Indicators as the Associated Contact Devices Are Operated," Renders Claim 3 Invalid Under R. S. 4888.

Claim 3 is a sub-combination claim to one of the individual units which when assembled in a group comprise the Gibbs game.

As functionally drawn, claim 3 reads on the Nakashima game as well as on the Gibbs game. The only possible novelty of Gibbs as defined in claim 3 over Nakashima resides in the element

"means for energizing, etc."

The Halliburton case condemned as functional the element:

"means \* \* \* for tuning."

If one phrase is functional so is the other. Therefore Gibbs claim 3 is void under R. S. 4888 the same as Walker.

Respondent's contention that he is outside the Halliburton doctrine because he has a *combination* claim with *three* functional statements *instead of one* as in Walker is untenable. The Halliburton decision applies to *all* combination claims!

If claim 3 were in non-functional language as required by the Statute it could not be infringed by either Fawn game, since they do not employ relays to energize their indicators.

The new Fawn game does not infringe claim 3 in any event because it has no win light or bell.

**B. Claims 6-10 Are Also Invalid Under R. S. 4888. Because Like Claim 3 They Employ Functional Language to Define Their Only Novelty Over the Nakashima Patent.**

These claims purport to cover the assembly of a plurality of the Gibbs individual game units.

The first part of each claim reads on Nakashima, and the second part reads on the competitive game patents to Chester, Higuchi, Wallace and Prina. Parts II of claims 6 and 9 are purely functional in their language. Therefore, *the only novelty* in the claimed combination over Nakashima is stated in conveniently functional language.

Hence claims 6 and 9 and their dependent claims 7, 8 and 10 are invalid under R. S. 4888.

If these claims were written in non-functional language they would not be infringed by either Fawn game.

## POINT II.


Since Claims 6, 7 and 8 of the Gibbs Patent Were Held Not Infringed by the New Fawn Game Because It Omitted an Essential Element of Said Claims, Claims 9 and 10 Which Include the Same Essential Element Are Not, as a Matter of Law, Infringed by the New Fawn Game,

The failure of the lower courts to hold claims 9 and 10 not infringed by the new Fawn game, either:

- (1) raises a novel point of law, or
- (2) requires instruction to the lower courts as to the existing law.

The Trial Court found the Gibbs game to be competitive. The Court found the new Fawn game *not* to be competitive because it was clock-operated. Therefore it found no infringement of claim 6 because it claimed a *competitive* game.

But claim 9 *also* claims a *competitive* game in language almost identical with claim 6. Therefore it was clear error not to hold claim 9 and its dependent claim 10 *not* to be infringed.



## ARGUMENT.

The Claims in Suit Are Invalid Under R. S. 4888 and the Doctrine of *Halliburton v. Walker*, Because They Do Not Particularly Point Out or Distinctly Claim the Invention, but on the Contrary Use the Functional Statement "Means for Energizing," "Means Whereby," and "Means for Discontinuing," at the Exact Point of Novelty.

The requisite for definiteness in the specification and claims of a patent is statutory.

R. S. 4888 provides that:

"Before any inventor or discoverer shall receive a patent for his invention or discovery, \* \* \* he shall *particularly point out and distinctly claim* the part, improvement, or combination which he claims as his invention or discovery. \* \* \*

The doctrine that patent claims must be definite, clear and unambiguous has been consistently followed by this Court. In the early case of *Merrill v. Ycomans*, 94 U. S. 568, 573, it was said:—

"The developed and improved condition of the patent law, and of the principles which govern the exclusive rights conferred by it, *leave no excuse for ambiguous language or vague descriptions*. The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights. \* \* \* *It seems to us that nothing can be more just and fair, both to the patentee and to the public, than that the former should understand, and correctly describe, just what he has invented, and for what he claims a patent.*" (Emphasis added.)

The *Merrill v. Yeomans* case was cited with approval many years later by Mr. Justice Brandeis in the case of *Permutit Co. v. Graver Corp.*, 284 U. S. 52, 60, with the statement that:

"The statute requires the patentee not only to explain the principle of his apparatus and to describe it in such terms that any person skilled in the art to which it appertains may construct and use it after the expiration of the patent, but also to inform the public during the life of the patent of the limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not." (Emphasis added.)

While the soundness of this general rule has never been seriously disputed, the scope to be attributed to the terms of the statute has often risen to plague the courts and litigants. The matter of functionality in claims, particularly where that functionality is at the exact point of novelty, has been the subject of many and diverse rulings in the past.

The controversy insofar as it applied to product claims, was finally settled by the decision of this Court in *General Electric Co. v. Wabash Appliance Corp.*, 304 U. S. 364, 37 U. S. P. Q. 466, in which case Mr. Justice Reed, speaking for the Court, said:

"\* \* \* But the vice of a functional claim exists not only when a claim is wholly functional, if that is ever true, but also when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty."

However, since the *General Electric* case involved only product claims, the question soon arose as to whether or not the rule enunciated therein applied to apparatus claims.

This further question was definitely resolved in the case of *Halliburton Oil Well Cementing Co. v. Walker, et al.*, 329 U. S. 1, 71 U. S. P. Q. 175, wherein this Court speaking through Mr. Justice Black stated as follows:

"The language of the claim thus describes this most crucial element in the 'new' combination in terms of *what it will do rather than in terms of its own physical characteristics* or its arrangement in the new combination apparatus.

\* \* \* \* \*

"Patents on machines which join old and well-known devices with the declared object of achieving new results, *or patents which add an old element to improve a pre-existing combination*, easily lend themselves to abuse. And to prevent extension of a patent's scope beyond what was actually invented, Courts have viewed claims to *combinations and improvements* or additions to them with very close scrutiny. \* \* \*"  
(Emphasis added.)

In pointing out that the requirement for definiteness in claims was not a new doctrine and that it applied particularly to machines which were a combination of old elements, the Court further stated:

"These principles were again emphasized in *Merrill v. Ycomans*, 94 U. S. 568, 570, where it was said that '... in cases where the invention is a *new combination of old devices*, he (the patentee) is bound to describe with particularity all these old devices, and then the new mode of combining them, for which he desires a patent.' This view has most recently been

reiterated in *General Electric Co. v. Wabash Electric Co.*, *supra*. Cogent reasons would have to be presented to persuade us to depart from this established doctrine. The facts of the case before us, far from undermining our confidence in these earlier pronouncements, re-enforce the conclusion *that the statutory requirement for a clear description of claims applies to a combination of old devices.*" (Emphasis added.)

The Walker patent involved in the *Halliburton* case was concerned with locating the fluid level in a well and included means for creating a pressure wave in the well and a system for recording on a chart the time when the wave was initiated and the time when echoes returned from obstructions in the well. This broad concept was old when Walker entered the field, having been previously disclosed in a patent issued to Lehr and Wyatt in 1936.

The novelty of the Walker patent resided in the *addition* to the Lehr and Wyatt structure of an adjustable pipe which functioned as an acoustical tuned resonator so that better records could be made of echoes from tubing collars. This latter element which constituted the sole novelty in the Walker patent over the Lehr and Wyatt disclosure was described in the claim as:

"*means associated with said pressure responsive device for tuning said receiving means to the frequency of echoes from the tubing collars of said tubing section to clearly distinguish the echoes of said couplings from each other.*"

The Walker apparatus was a *combination* of *mechanical* and *acoustical* elements. The *Halliburton* case is therefore final and decisive authority for the proposition that

conveniently functional language at the exact point of novelty in *mechanical-acoustical* combinations is fatal to the claim.

It would seem that the Halliburton decision should have been accepted as applicable to *any apparatus claim* involving a combination of old elements. That this has not been the case is demonstrated by the fact that the lower courts in this case failed to apply the Halliburton doctrine to claims for a combination of *mechanical* and *electrical* elements.

It is difficult to conceive of claims more clearly on all fours with the claims in the Halliburton case than those of the patent in suit herein.

The single feature of novelty in the Walker claims was described as "means for tuning." Similar language is used in the Gibbs claims. For example, Gibbs' claim 3 describes the *single element of novelty* over the Nakashima patent as "means for energizing," but the only *means for energizing* disclosed in the Gibbs patent are the electrical relays R and their associated armatures R'. These relays which are a critical part of respondent's apparatus are even more indefinitely referred to in claims 6-10.

Claims 6-10 use the functional statements "means whereby" and "means for discontinuing" when describing the manner in which the individual game units are interconnected to make the complete assembly operable.

It is petitioner's belief that this Court did *not* mean to restrict the Halliburton doctrine to that small class of apparatus patents involving combinations of mechanical and *acoustical* elements, but that on the contrary this Court meant to and did *condemn the use of functional language in all kinds of apparatus claims, including combinations of mechanical and electrical components.*

- A. The Definition of the Only Element of Novelty in Claim 3 by the Functional Statement "Means for Energizing the Indicators as the Associated Contact Devices Are Operated," Renders Claim 3 Invalid Under R. S. 4888.

Claim 3 is a *sub-combination* claim to the *individual* playing units. Each of the Gibbs game units has a playing board with rows of holes therein and an annunciator backboard with an indicator light thereon for each of said holes. When a ball is rolled into any one of the holes on the playing board a contact device beneath the hole is operated and the corresponding indicator lamp on the annunciator panel is energized. The indicator remains energized during the balance of the play in order to give visual evidence of the progress thereof. Each unit also includes an open electrical circuit which is closed when a win has been made, and *supplementary* signal means in the form of a light or bell for indicating said win.

This precise game unit is fully disclosed by the Nakashima patent [R. 378].

Respondent argued in opposition to the Petition for Certiorari that his game was distinguishable from Nakashima because he (Gibbs) uses only one ball and twenty-five lights whereas Nakashima uses three balls and nine lights. The answer to this contention is of course that *claim 3 does not specify any particular number of balls or lights whatsoever*. As a matter of fact, claim 3 does not even specify holes in the game board.

Gibbs also seeks to distinguish his game from that of Nakashima because his indicators and contacts correspond in arrangement and are sub-divided into corresponding groups. But if this is a material difference, then there can be no infringement by Petitioner since *his* indicators and contacts *likewise do not* correspond in arrangement and are *not* subdivided into corresponding groups. As a matter of fact, neither do those of Respondent's licensee in Long Beach.

Considering now the wording of claim 3 as previously outlined herein we see that the claim calls for an individual game unit, the first element of which is:

- (a) a board having a plurality of contact devices thereon adapted to be engaged by an object moved over the board by a player, a plurality of indicators, means for electrically connecting said indicators with a source of electric current and with said contact devices, said indicators and said contact devices corresponding in number and arrangement and subdivided into corresponding groups.

Referring to the Nakashima drawings [R. 376-378], we see that Nakashima meets the terms of the above element in that he provides a board 6 having spring contacts 18, 19 on the under side thereof, balls 10, a plurality of indicator lamps 12 corresponding in number to the contact devices, and wiring connecting said indicators and lamps with each other and with a source of current. Additionally, Nakashima shows apertures in his game board as used by Gibbs but not included in claim 3.

Referring to Fig. 4 of Nakashima [R. 378] we see that elements (c) and (d) of claim 3, to-wit,

- (c) an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized, and
- (d) supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized.

are also clearly present in Nakashima. The bell 14 in Nakashima is the supplementary signal means of element (d) and the circuit therefor, terminating in the transformer winding 433, is the circuit called for in element (c).

Thus we see at the outset that Nakashima clearly anticipates elements a, c and d of claim 3. This leaves only element (b) upon which patentability may be predicated.

The parallel between claim 3 and the claims in the Halliburton case is obvious.

While the indicators of Nakashima are "energized as their associated contact devices are operated," as called for in element (b) of claim 3, Nakashima does not employ *separate* means for this purpose as does Gibbs. Nakashima maintains his indicators energized by the simple expedient of permitting the playing balls to remain in contact therewith. (Which meets the literal terms of element b).

The only possible feature of novelty in the game unit described in Gibbs' claim 3 is the *separate means* (Gibbs relays R) for maintaining the indicator lamps energized.

Nakashima did not need separate means because he maintained his indicators energized by keeping their respective contact devices closed. Gibbs, however, employing a switch that is only *momentarily* closed *must* have *separate* means for *maintaining* his indicators energized. This separate means defined functionally in element (b) is found in the relays R of the Gibbs game.

We come inescapably to the conclusion therefor that the only possible novelty in the Gibbs game as defined in claim 3 over the Nakashima patent resides in the use of relays R which are described in said claim as:

*"means for energizing said indicators as the associated contact devices are operated."*

In the Halliburton case the only element not found in the prior Lehr and Wyatt patent was Walker's adjustable pipe. In the claims this was described as:

*"means \* \* \* for tuning said receiving means to the frequency of echoes from the collars of said tubing sections."*

On the face of it the quoted statement from Gibbs' claim 3 is *even more functional* than the quoted statement from the Walker claims.

It is readily apparent therefore that claim 3 does not meet the requirements of R. S. 4888 because it uses "conveniently functional language at the exact point of novelty."

But says Respondent, the Halliburton decision does not apply to me because I have a *combination* claim. I have

*no single element of novelty. All of my elements are old and I claim a patentable combination thereof.*

The obvious answer to this contention is present in the previously quoted excerpts from the *Halliburton v. Walker* case one of which states:

"Patents on machines which join old and well known devices \* \* \* or patents which add an old element to improve a pre-existing combination, easily lend themselves to abuse.

\* \* \* in cases where the invention is a *new combination of old devices* he (the patentee) is *bound to describe with particularity* all these old devices, and then the new mode of combining them for which he desires a patent." (Emphasis added.)

There is nothing whatsoever in the *Halliburton* case to indicate that it meant to exclude claims for a combination of *old* elements where one or more of the elements is defined in *functional* language.

The Respondent himself has divided claim 3 into eight elements, of which *three* are described functionally as "means," one of these three being the above-discussed "means for energizing." Certainly the Gibbs claim 3 cannot escape the Halliburton doctrine merely *because it has three* functional statements in it rather than *one*.

From the previous discussion it is apparent that due to its use of broad functional language, claim 3 is fully anticipated by the Nakashima patent. Nakashima not only has all of the structure of elements (a), (c) and (d)

of the claim, but he also meets the functional terms of element (b), for the Nakashima indicators *are in fact energized as his associated contact devices are operated.*"

That Nakashima did not provide *separate* means for accomplishing this purpose is beside the point in view of the functional wording of the claim.

The only possible way for claim 3 to be valid over Nakashima is to "*read into it*" the relays R and their associated armatures R'.

But the Respondent cannot now contend for such an interpretation because at the trial he committed himself to a literal and functional interpretation of the claim. *This he was compelled to do in order to find infringement by the old Fawn game.*

Pursuant to Respondent's contentions below, the Trial Court and the Circuit Court both adopted his interpretation of claim 3 and held the Fawn games to infringe said claim, in spite of the fact that instead of using relays as Gibbs does, both of the Fawn games employ *a simple overbalanced paddle* or "see-saw" switch of the type shown in the Schneider patent [R. 408] and the Blackmore patent [R. 515].

Respondent contends that the Fawn gravity-operated paddles are the equivalent of the Gibbs electrical relays because the Fawn switch remains closed, thus causing the lamps to stay energized. However, Respondent ignores the fact that Nakashima's switch *also* remains closed causing *his* lamps to stay energized.

Any interpretation of claim 3 which causes it to read on the Fawn games also causes it to read on the Nakashima game. Conversely, if claim 3 is limited to the relays R so as to avoid Nakashima, it is likewise avoided by the Fawn games.

Additionally it will be remembered that the *new* Fawn game has no win light or bell and hence does not infringe claim 3.

### Summary Re: Claim 3.

1. The phrase "means for energizing said indicators as the associated contact devices are operated" defines the only novelty of claim 3 over the Nakashima patent.
2. Said phrase is wholly functional.
3. Claim 3 is therefore invalid for failure to meet the particularity required by R. S. 4888.
4. When literally/construed as contended for by Respondent, claim 3 is anticipated by Nakashima because the indicators of Nakashima are in fact "energized as their associated contact devices are operated."
5. If claim 3 is judicially narrowed by inclusion of the relays R to describe the invention of Gibbs in *non-functional* terms it clearly is *not* infringed by either of the Fawn games.
6. Gibbs by the use of said functional language in claim 3 has been able to extend his monopoly beyond the true scope of his invention and thus prevent the use by others of otherwise unpatented game units.

**B. Claims 6-10 Are Also Invalid Under R. S. 4888 Because Like Claim 3 They Employ Functional Language to Define Their Only Novelty Over the Nakashima Patent.**

Claims 6 and 9 each describe in the first portion thereof the construction of the individual game units, and then in the latter part of the claim they recite in *functional* language the interconnection of said units to form a complete game assembly.

In claim 6 elements (a) and (b) refer solely to the construction of the individual units and in claim 9 elements (a), (b) and (c) describe this construction. In each claim, however, the description of the individual game units is in broad language that reads fairly and squarely upon the Nakashima patent.

Likewise the last element (d) of each claim, because of the functional language employed, reads on the rabbit game of Higuchi, the pig game of Wallace, the dancing game of Chester and the lamp game of Prina.

Here again we have a combination of admittedly old elements, *all of which are disclosed in the Nakashima patent, except* the means of interconnecting the individual game units. This latter element however is described in broad functional language which by its terms reads on the mentioned prior patents.

It is submitted, therefore, that claims 6 and 9 and their dependent claims 7, 8 and 10 fail to meet the requirements of R. S. 4888 because they *fail to point out the invention* with the particularity required by the statute as interpreted in *Halliburton v. Walker*.

## DISCUSSION OF CLAIM 6.

By reference to claim 6 we find that it comprises two parts. First, a description of an individual game unit, and second, the means for connecting a plurality of these units together. These parts are here set forth as follows:

### Part 1.

- (a) each of said units including a plurality of contact devices and a plurality of indicators corresponding in number and subdivided into corresponding groups,
- (b) *means for* electrically connecting the contact devices with the corresponding indicators, said indicators *adapted to be operated when and as objects are moved by the players into engagement with the contact devices.*"

Even a casual reference to the Nakashima patent shows that the above-quoted elements are in such broad language as to read directly on the Nakashima game.

Continuing with claim 6 we see that the balance thereof describes the manner in which a plurality of Nakashima game units may be connected to make a competitive game by merely providing:

### Part 2.

- (c) *means for* electrically connecting said units together and with a source of electric current and
- (d) *means whereby* when all of the indicators in any group of any one of said units have been operated to complete a winning play the indicators on all of the units except the winning unit *will be de-energized*, while the indicators at the winning unit will remain energized, for the purpose described.

Element (d) goes to the very heart of any competitive game because it describes the very necessary function of *automatically disconnecting* all non-winning units *immediately* upon a win being made by any of the units.

This necessity was long known in the art and accounts for the fact that each of the prior art competitive game patents shows apparatus and circuits for accomplishing this purpose. By way of example the Chester patent [R. 433] discusses this salient feature commencing at line 57 and terminating at line 80. Chester states (lines 77-80) that if the players are as little as  $1/200$  of a second apart "the circuit breaker 62 would operate to thus *disconnect the circuits of all of the other units* to prevent any further actuation of the same."

By a comparison of Exhibits G and H [R. 529 and R. 531] it will be seen that Chester's circuit for accomplishing this result is substantially identical with that of Gibbs. As matter of fact, no contention has been made by Gibbs for any novelty in any of his circuits.

It is thus seen that if claim 6 displays any invention at all over Nakashima it must reside in the specific circuits and relays used for interconnecting the individual game units. Furthermore, it is seen that the method used by Gibbs for this purpose is shown by Chester [R. 424], Wallace [R. 436], Higuchi [R. 460] and Prina [R. 470].

It is submitted that no invention was necessary for Gibbs to connect a plurality of the Nakashima game units in the manner taught by Chester, Wallace, Higuchi and Prina. Be that as it may, however, the Respondent cannot be heard to say that Part II of his claim which describes this interconnection of his individual units is not an essential element of the claim.

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Since Part II of claim 6 describes the only novelty over Nakashima by the functional statement "means whereby \* \* \* the indicators \* \* \* will be de-energized \* \* \*," it too, is void under R. S. 4888 and the Halliburton doctrine.

Attention is also called to element (b) of claim 6 which covers the relation between the contact devices and the indicators. This element corresponds to element (b) of claim 3 previously discussed, but in even more functional language than claim 3.

Element (b) of claim 6 *does not even specify* "means for energizing" but merely states functionally that the indicators are "*adapted to be operated*" when and as the objects are moved by the players into engagement with the contact devices. By use of the broader terminology "*adapted to be operated*" this element literally includes indicators such as the movable rabbits, pigs and the like of the prior art.

By reference now to element (a) of claim 6 we see that it does not specify a *game board* or *apertures* nor does it specify that the "objects" move over a board or in any given path or manner. Neither does claim 6 define the type of object used. Insofar as the *wording of the claim goes*, claim 6 describes the Prina game as accurately and fully as it describes the Gibbs game. The Prina patent [R. 470] shows a plurality of game units each having a plurality of aligned indicator lamps 1-9 which are successively energized when and as a shoe 20 passes over aligned contact buttons 1a-9a. Electrical means are provided to de-energize all non-winning game units when a win is made on any unit. Also a win lamp 10 is provided.



For the reasons previously stated as to the invalidity of claim 3 under R. S. 4888 it is submitted that claim 6 is even more vulnerable than claim 3 because when all is said and done, *the only invention, if any, in the Gibbs game resides in the use of the relays R and their associated armatures R' to maintain the indicators energized.* But this feature is described in the claims only in functional language.

As with claim 3, Respondent contends that claim 6 does not come under the Halliburton doctrine *because it is a combination claim, and that no one element can be said to be the dominant feature of novelty.* However, out of the four elements in claim 6, three of them are stated in functional language.

Elements (b) and (c) use the term "means for" and "adapted" while element (d) uses the term "means whereby." On their face such phrases are purely and wholly functional and cannot possibly satisfy the statute. Consequently claim 6 is clearly invalid.

If claim 6 had been written with sufficient particularity to include either the relays R in element (b) or the specific circuits and relays involved in element (d) there could be no infringement by either Fawn game.

As with claim 3, Respondent by the use of broad functional language has been enabled to prevent the use by others of apparatus within the public domain. Such unlawful extensions of the patent monopoly by the use of functional language is the exact vice condemned by this Court in the General Electric and Halliburton cases.

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1949.

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No. 19.

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TODD C. FAULKNER, *Petitioner*,

*vs.*

JOHN T. GIBBS, *Respondent*.

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**REPLY BRIEF FOR TODD C. FAULKNER,  
Petitioner.**

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**Introduction.**

Respondent's Brief is devoted principally to a discussion of matters *ancillary* to the specific issues before this Court, which are:

QUESTION 1. Is the doctrine of *Halliburton Oil Well Cementing Co. v. Walker, et al.*, 329 U.S. 1, 67 S.C. 6, 71 USPQ 175, condemning the use of indefinite and functional language at the exact point of novelty in patent claims for a combination of mechanical and acoustical elements, applicable to claims for a combination of mechanical and electrical elements where the only feature of novelty in the claims is described broadly in terms of "means",

## DISCUSSION OF CLAIM 9.

Elements (a) and (b) of claim 9 specify the subject matter of elements (a) and (b) of claim 6 plus a game board having apertures therein and further specify that the contacts be adjacent the apertures and that the indicators are energized when the objects are deposited in the apertures.

Additionally claim 9 specifies in element (c) a supplementary signal circuit with means for holding it open during play and closing it when a win has been made.

However, since the Nakashima patent discloses apertures with contacts adjacent thereto and a supplementary signal circuit operable when a win is accomplished, it completely and fully meets all of that portion of claim 9 which refers to the construction of the single units to-wit: elements a, b and c.

This leaves only element (d) of claim 9 to supply the novelty required under the statutes.

Element (d) covers all the subject matter of element (d) in 6 since it specifies *means for discontinuing* the signals and opening the circuits of all the indicators on *all other* units. However, claim 9 is slightly narrower than claim 6 in that it *additionally* specifies that the means for discontinuing are "controlled by the closing of the signal circuit of the winning unit," whereas claim 6 is not so limited.

However, element (d) of claim 9 is nevertheless anticipated by the competitive games of Chester, Higuchi,

Prina and Wallace. Furthermore, it is apparent on the face of it that the term "means for discontinuing" is equally as functional as the term "means whereby the indicators will be de-energized," used in claim 6.

We see therefore that the *only* novelty of claim 9 over the Nakashima patent is described in conveniently functional language. Claim 9 is clearly on all fours with the claims held invalid in the Halliburton case, since "means for discontinuing," used by Gibbs, is equally if not more functional than the phrase "means for tuning," held to be functional in said case.

It is therefore submitted that claim 9 like claims 3 and 6 is clearly void ~~as~~ not defining the Gibbs invention with the particularity required by R. S. 4888 and the *Halliburton* case.

Like claim 6, claim 9 is devoid of any invention as required by R. S. 4886 because it merely recites the interconnection of a plurality of Nakashima units by means disclosed in the competitive game patents of record.

Similarly if in place of the functional language used in claim 9 to describe the individual units the relays R had been included in the claim, or if the functional language describing the means for interconnecting and operating the plurality of units had been sufficiently definite under the statutes, there would be no infringement by either Fawn game.

However, as will hereinafter be discussed, the new Fawn game does not infringe claim 9 even with its broad functional language.

or is said decision to be ignored as was done by the Court of Appeals in this case?

QUESTION 2. Where a court holds an accused apparatus not to infringe certain patent claims because said apparatus does not include an essential element of said claims, is it not contrary to fundamental law and logic for the court in the same decision to hold other claims of said patent which specify the same essential element, infringed by the said accused apparatus?

Nowhere in his brief does Respondent directly meet either of said questions.

Points I and II of Respondent's argument (see page 13 of his Brief) are directed to a discussion of F.R.C.P. 52(a) and its application to patent cases. Respondent states that invention and infringement are questions of fact; that concurrent findings below should not be disturbed unless *clearly* erroneous, and that the findings of the court below in this case are supported by the evidence.

Petitioner believes that this case comes within the *exception* to the rule, i.e., that the findings below are *clearly erroneous*.

Respondent's Point III asserts that the Gibbs' claims define patentable combinations and that the courts below were not in error in holding them valid. The *Halliburton v. Walker* decision which is directly involved in this appeal is nowhere mentioned in this discussion.

The *Halliburton* case is, however, discussed in Respondent's Point IV, his contention being that while its *result* may be correct, its *reasoning* is erroneous. Respondent in this portion of his Brief re-argues the *Halliburton* case at length and contends as follows:

1. That the decision in the *Halliburton* case *could* have been predicated upon other grounds.
2. That the court's reasoning was erroneous.

3. That said reasoning was erroneous because the Court was led into error by counsel for Halliburton.
4. That as a consequence of counsel's erroneous statements, this court read and applied *the wrong part* of the statute to the case.
5. That if this court (by a majority of 8 to 1) had read the statute *correctly*, it would not have made said mistake.

Since Respondent has not seen fit to directly discuss either of the legal questions herein, and has departed from the order of presentation used in Petitioner's Brief, we here re-state the points of our argument, as follows:

PETITIONERS' POINT I. The Claims in suit are invalid under R.S. 4888 and the doctrine of *Halliburton v. Walker*, because they do not particularly point out or distinctly claim the invention, but on the contrary use the functional statements, "means for energizing", "means whereby", and "means for discontinuing", at the exact point of novelty.

A. The definition of the only element of novelty in Claim 3 by the functional statement, "*means for energizing said indicators as the associated contact devices are operated*", renders Claim 3 invalid under R.S. 4888, in view of the Nakashima patent.

B. Claims 6-10 are also invalid under R.S. 4888 *because like Claim 3 they employ functional language* to define their only novelty over the Nakashima patent.

PETITIONERS' POINT II. Since Claims 6, 7 and 8 of the Gibbs' patent were held not infringed by the New Fawn Game because it omitted an essential element of said claims, Claims 9 and 10 which include the same essential element are not, as a matter of law, infringed by the New Fawn Game.

## POINT II.

Since Claims 6, 7 and 8 of the Gibbs Patent Were Held Not Infringed by the New Fawn Game Because It Omitted an Essential Element of Said Claims, Claims 9 and 10 Which Include the Same Essential Element Are Not, as a Matter of Law, Infringed by the New Fawn Game.

While a ruling favorable to the Petitioner under Point I will result in a reversal of the judgment below it is nevertheless believed that it is in the public interest for this Court to correct the error committed by the lower courts which gave rise to our Point II.

The ruling of the courts below that relatively narrow claims 9 and 10 were infringed by the new Fawn game in spite of the fact that broad claim 6 and its dependent claims 7 and 8 were held *not to infringe*, either raises a distinct question of law that should be settled by this Court, or exhibits such a misconstruction of existing law by the lower courts as to warrant this Court in exercising its supervisory power to instruct the lower courts in the law. Otherwise the same error may be repeated in the future to the prejudice of other innocent litigants.

It is for this reason that we urge this Court to fully consider our Point II and either restate the law involved or instruct the lower court as to that law.

As set forth in our Petition for Writ of Certiorari and as admitted by Respondent, the Gibbs game is a competitive group game. It is competitive because as Respondent admitted, and as the Trial Court found, the play continues until one player makes a winning combination on his individual game unit. As soon as a winning combination is made, *all of the other units are immediately*

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**Respondent's Points I and II Are Ancillary to the  
Issues of this Case.**

Pages 14 to 34, inclusive of Respondent's Brief develop the theme that the findings below should not be disturbed because they are *not clearly* erroneous.

As stated, we firmly believe that the findings herein come within the *exception* to the rule, in that they are "clearly erroneous". Specifically so as to petitioner's Point II.

So that the court would be fully advised of our position on ancillary as well as major issues, we pointed out in our opening Brief the more salient errors below, such for example as:

1. That the claims in suit if *literally* construed are invalid over the prior art; and if *narrowly* construed are *not* infringed by either Fawn game.
2. That all of the claims in suit are invalid for lack of novelty and invention.
3. That the *new* Fawn game does not in *any event* infringe any of the claims in suit.

This case, however, is before this court on a pure *question of law*. As to this question of law, the concurrent findings below are neither material nor relevant.

Respondent's argument under his Points I and II is neither material nor relevant to the controlling issues of this case, but pertains solely to the *ancillary* issues, which this court has, of course, the right to consider, once having taken jurisdiction.

*de-energized* to prevent further play which might result in allegedly tie games and arguments. This feature of the Gibbs game is set forth in element (d) of both claims 6 and 9.

In the new Fawn game *there is no competition* between the players since a time clock operates the game for a specified time and *no units are shut down until a switch is operated by the time clock* at the expiration of the specified time.

This *essential difference* between the new Fawn game and Respondent's game was the basis for the Trial Court ruling that claims 6, 7 and 8 were not infringed. Illustrative of this fact is the statement by the Trial Court at R. 262 as follows:

"The Court (to Mr. Huebner): \* \* \* *That is the fundamental distinction*, that while there is a possibility that several persons may win; and also the possibility that no one might win in his (Petitioner's) game while your (Gibbs) game goes on until somebody wins. *So here are two differences in results.* His game stops automatically after a minute and a half. Your game goes on until somebody wins."

At R. 266 the Court continuing its discussion with counsel for Respondent stated further:

"It seems to me that the latter part of that claim (6) the wording would not be read on the altered game, as you call it, *the new game, because there is no de-energization*, de-energization does not occur, because the game goes on."

**Respondent Fails to Negative the Fact that the Only Features of Novelty Over the Prior Art Are Claimed Solely in Functional Language.**

In attempting to show that the Gibbs claims are not bad for functionality, the Respondent states on page 51 of his Brief, as follows:

"The Gibbs apparatus differs from Nakashima fundamentally."

Respondent, however, is here comparing with Nakashima the Gibbs game as shown in the specification and drawings of the patent in suit, rather than as defined in the claims in suit.

We concede that Gibbs may have made an invention. We concede also that Claims 1, 2, 4 and 5, *not here in suit*, may adequately describe that invention because they, contrary to the claims in suit, *include as elements thereof* the momentary operation of the contact devices, the relays, the armatures for the relays, etc., all essential to the Gibbs game.\*

Respondent stresses in his Brief that *all* of the elements of his game are old. To prove this, he breaks claim 3 down (pp. 49 and 50) into seven elements. These elements are as follows (see p. 49):

1. "A board having"
2. "A plurality of contact devices (switches) thereon adapted to be engaged by an object moved over the board by a player."

\* Respondent relies on Gibbs v. T. Z. R., etc.; but said case is totally irrelevant to this case because, as stated in Respondent's Brief, the T. Z. R. game was a *complete copy* of the Gibbs game. This is evident from the fact that *even the narrow* claims of Gibbs, *not here in suit*, were found to be infringed, which could not have been the case otherwise. Petitioner's Fawn games are *not* copies of the Gibbs game, and hence the T. Z. R. decision is not relevant here.

Later at R. 287 in its opinion at the close of the argument the Court stated:

“\* \* \* the (new) Fawn game is played for a definite time,—a minute and a half, making it possible for two persons to win during the course of the game, one after the other. *The Gibbs game is played strictly on a competitive basis* and the moment one winner has won, the play of the others stops automatically. \* \* \*

The result is that *under the Fawn game there can be any number of winners, and it is possible that no one should win*, during that time, while under the Gibbs game only one player may win, and there is always a winner because the game does not stop until one person has won. In the other (new Fawn) game, as I have already stated, the time clock automatically stops all games \* \* \*

“*I do not think that claim 6 is infringed, and I think if you read them the way counsel desires me to read them they would fall under the interdict of the recent decision of the Supreme Court in Halliburton vs. Walker.*”

It is abundantly clear that the trial court found claims 6, 7 and 8 *not* to be infringed by the new Fawn game because these claims are limited to a *competitive game* where when one player wins, *the other game units are automatically de-energized, whereas the new Fawn game is not a competitive game because the other game units are not de-energized when a win is made on one unit.*

However, after holding claims 6, 7 and 8 *not* infringed by the new Fawn game, the Trial Court then erroneously held that claims 9 and 10 *were* infringed.

Respondent discusses these elements together at the top of page 23 of his Brief, and asserts that *because* of these elements, Claim 3 "in its inception *distinguishes and departs* from the principal construction and function of the Nakashima prior art patent."

But the only support for this statement is found in the preceding paragraph appearing at the bottom of page 22 of Respondent's Brief, where he states that "in the Gibbs game a *single ball* is used, which, having entered a hole and having *actuated* an electric switch, *returns* to the player for a replay."

Referring, however, to the wording of Claim 3, we see that:

- A. It does *not* specify *any holes* in the board.
- B. It does *not* specify a *ball* (it merely refers to an "object" not included as an element of the combination).
- C. It is *not* limited to a *single* ball or "object".
- D. It does *not* specify that the ball or "object" *enters* a hole.
- E. It does *not* specify that the "object" *actuates* a contact device.
- F. It does *not* specify that the ball or "object" *returns* to the player.
- G. It does *not* specify *where* the contact switches are located with respect to the board except that they shall be "thereon".

*Not one* of the features attributed by Respondent to elements 1 and 2 of his Claim 3 is actually recited in said claim.

Looking at what the claim *does* call for, and at the Nakashima patent, we see that Nakashima clearly shows:

**Element 1.** "A board having"

A simple comparison of element (d) of claims 6 and 9 shows that they *each* are directed to a *competitive* game in which a win on one unit results in de-energizing, i. e., disconnecting all non-winning game units. In claim 6 this feature is set forth as follows:

- (d) *means whereby when all of the indicators in any group of any of said units have been operated to complete a winning play, the indicators on all of the units except the winning unit will be de-energized, while the indicators at the winning unit will remain energized for the purpose described.*

In claim 9 this feature is described as

- (d) *means controlled by the closing of the signal circuit of the winning unit for discontinuing the signals and opening the circuits of the indicators on all other units.*

Since the above language quoted from claim 6 describes a competitive game *as held by the Trial Court, the companion language* quoted above from claim 9 *must also describe a competitive game.*

The phrase in element (d) of claim 9 "controlled by the closing of the signal circuit of the winning unit" is a further limitation tending to *narrow* claim 9 over the disclosure of claim 6. *It does not broaden claim 9 in the slightest.*

Claim 6 specifies that the indicators on non-winning units shall be de-energized while the indicators on the winning unit remain energized. In claim 9 this same feature is expressed in different words by stating that when a win has been made the circuits on *all* of the *other* units are opened. The use of the word "other" in claim

**Element 2.** "a plurality of contact devices thereon (switches under the holes) adapted to be engaged by an object (ball) moved over the board by a player."

How then can Claim 3 "at its inception *distinguish and depart*" from Nakashima? The answer of course is, that it *does not*. On the contrary, Nakashima meets elements 1 and 2 fully and completely.

Referring now to the other elements in Respondent's outline (page 50), we note the following:

**Element 3.** "a plurality of indicators."

Nothing is said here as to the *type* of indicators to be used or *where* they are to be located. Insofar as the claim is concerned, the indicators may be lights, pigs, rabbits, dancers, bells, or what-nots, as desired. These indicators may, *insofar as the claims is concerned*, be located on, over, under or behind the game board, or might be hung from the ceiling, or located in another room. If the indicators meant to be included in this element are electric lamps, as disclosed by Respondent, *then they are shown in Nakashima*.

**Element 4.** "*means for electrically connecting said indicators with a source of electric current and with said contact devices.*"

These are of course the wires which connect the switches of element 2 with the indicator lamps of element 3, as found in *both* Gibbs and Nakashima.

**Element 5.** "*means for energizing said indicators as the associated contact devices (switches) are operated.*"

In the Gibbs game, said "means" are the twenty-five relays R and their twenty-five associated armatures R', which are in turn associated with the contact devices (switches) disposed in the twenty-five holes in the game board. *No alternative* means for accomplishing energization of the indicators are shown or even suggested in the

9 obviously states the same thought as stated by the word "except" in claim 6.

In claim 6 the de-energization of the competing units is stated broadly, *whereas in claim 9 it is limited to a system controlled by the signal circuit.* It is apparent that whatever synonym is used for the word "controlled," it cannot affect the plain meaning of the claim.

Since claims 6, 7 and 8 were held *not* to be infringed by the new Fawn game because of the omission of the above-quoted element, *it follows as a matter of law* that claim 9 likewise cannot be infringed since it describes the *same element in almost identical language.*

It is submitted therefore that the decision of the lower courts finding claims 9 and 10 infringed by the new Fawn game should be expressly reversed irrespective of the ruling on Point I.

### Conclusion.

1. The claims in suit are invalid under R. S. 4888 because they use functional language at the exact point of novelty as condemned in the case of *Halliburton v. Walker.*

2. If the claims in suit had been drawn in compliance with the statute, instead of in functional language which unduly extended their scope, there could have been no infringement by Petitioner.

3. Respondent by the use of functional claims has been enabled to extend his monopoly beyond the true scope of his invention, if any, and thus has prevented the use by others of otherwise unpatented machines.

4. In spite of the functional breadth of the claims in suit they are not infringed by the new Fawn game.

Gibbs specification. The Gibbs contact devices (switches) are only *momentarily closed*, and their sole function is to energize the relays R. The relays R move the armatures R' to circuit-closing position to energize the indicators. The indicators are maintained energized by the armatures R' *after* the contact switches have *reopened*.

In Petitioner's game, as in Nakashima's, the indicator lamps are energized and kept energized solely by reason of, and *only so long as*, their contact switches are kept closed. Nakashima uses the weight of the ball to keep the switch closed, while Petitioner substitutes therefor, the weight of his over-balanced paddle. Neither employs a counterpart of Respondent's relays R and their armatures R'.

**Element 6.** "an electrical circuit common to all of said groups and open until all of the indicators in one of said groups have been energized."

No specific details of this circuit are given. No qualification of the groups is stated. When a win has been made in the Gibbs game by having five lights energized, a bell rings to indicate a win. In the Nakashima game, when three lights have been energized, a bell rings to indicate a win.

**Element 7.** "and supplementary means for indicating a winning play when all of the indicators in one of said groups have been energized."

The supplementary means in both Gibbs and Nakashima is the bell above-mentioned. (Gibbs also has a win *light* on each unit.)

Thus we see that Nakashima literally and completely meets both the structural and functional limitations of elements 1, 2, 3, 4, 6 and 7, of Claim 3 as above set forth. Furthermore, Nakashima completely meets the *function* of element 5, because he "energizes said indicators as the associated contact devices are operated."

5. By holding claims 9 and 10 infringed by the new Fawn game after holding claims 6, 7 and 8 not to be infringed, the lower Court committed manifest error.

6. The claims in suit also are invalid for lack of novelty and invention over the art of record. If sufficiently narrowed by judicial construction to be valid, they are not infringed by either of Petitioner's games.

The decision of the Court of Appeals for the Ninth Circuit should be reversed.

Respectfully submitted,

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Element 5 uses conveniently functional language to define the relays R and their associated armatures R' essential for maintaining the Gibbs indicators energized *after* his contact devices have *momentarily* closed ~~and then re-opened~~. This is the sole novelty over Nakashima.

✓ No counterpart of Gibbs' relays R and armatures R' is needed or employed by Nakashima, nor by Petitioner, since the latter, like Nakashima, maintains his indicators energized ~~by keeping his contact switches closed~~.

Respondent characterizes as the crux of his invention what he terms the "qualification and mutual relationship" of elements 2 and 3. The clause referred to states: "said indicators and said contact devices corresponding in number and arrangement and subdivided into corresponding groups." Respondent does *not*, however, say that this relationship is novel. Indeed it is not (see Hayashi R 383).

Respondent says on page 50 that this "qualification and mutual relationship" "sets his game completely apart from the Nakashima prior patent", but what Respondent does *not* say is that by the same token it *also* sets his game completely apart from Petitioner's games.

The clause of Claim 3 constituting the alleged qualification and mutual relationship does *not* state what the groups are comprised of nor to what they correspond. Nakashima and Petitioner have (a) groups of contacts, (b) groups of indicators, and (c) groups of circuits. Neither Petitioner nor Nakashima provide an arrangement of contact apertures corresponding to the arrangement of indicators. Petitioner's contact apertures are in two long horizontal rows unrelated to the arrangement of the indicators. Likewise Nakashima's "star" contact apertures are arranged in a manner unrelated to the arrangement of the indicators.

Respondent is therefore in the position of arguing to this court that the precise point of novelty or crux of his invention resides in the "Qualification and Mutual Relationship